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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,273	11/16/1998	DOREE D. SELIGMANN	2925-110P	9569

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/20/2004

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/192,273

Applicant(s)

SELIGMANN, DOREE D.

Examiner

Kenneth R Coulter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5-9 is/are allowed.
- 6) ☒ Claim(s) 4 and 10-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The declaration filed on 12/10/03 under 37 CFR 1.131 is sufficient to overcome the Wang et al. (U.S. Pat. No. 6,161,134) reference.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 4 and 10 - 51 are rejected under 35 U.S.C. 102(e) as being disclosed by Mattaway (U.S. Pat. No. 6,009,469) (Graphic User Interface for Internet Telephony Application).

4.1 Regarding claim 10, Mattaway discloses a method of operating a PDA, comprising the steps of:

arranging information within the PDA to correspond to at least one of first and second data sets, the first data set including phone features of a user, at least one of the phone features being set up in a telecommunication system for a particular phone number, the second data set including phone policies of the user, at least one of the phone policies being used for implementing the at least one of the phone features (col. 6, lines 1 – 3 “either of the first **processing unit 12** and the second processing unit 22 may be implemented in a **personal digital assistant (PDA)**”; col. 5, lines 49 – 51 “The **input device 18** may alternatively include connections to other computer systems to **receive** the input commands and the **data** therefrom.”; col. 20, lines 27 – 35 “Client table 1516A comprises a plurality of records ... Each WebPhone user ... has a separate record in table 1516A containing the information defining the **client’s profile of personal information.**”; col. 35 (Table 1)); and

transferring the arranged information to an Internet Protocol-Public Branch Exchange (IP-PBX) (Fig. 1, item 24; col. 14, lines 53 - 67).

4.2 Per claim 11, Mattaway teaches that said transferring step includes the step of connecting the PDA to the IP-PBX through the Internet (Fig. 1, item 24; col. 14, lines 53 - 67).

4.3 Per claim 4, Mattaway discloses a method of operating a Personal Digital Assistant (PDA) with an Internet Protocol (IP) phone device, comprising the steps of:

arranging information within the PDA to correspond to at least one of first and second data sets, the first data set including phone features of a user (Abstract; Figs. 5, 6, 14; col. 20, lines 27 – 35 ; col. 29, lines 18 - 37), the second set including phone policies of the user (Abstract; Figs. 5, 6, 14; col. 20, lines 27 – 35; col. 29, lines 18 - 37);

operating the IP phone device according to the arranged information (Abstract; Figs. 5, 6, 14; col. 14, lines 53 - 67; col. 29, lines 18 - 37).

However, Mattaway does not explicitly disclose prestored ID information of the user in the PDA.

It would have been inherent to prestore identity information in the PDA because security is a concern in Mattaway in the situation where the PDA is lost or stolen.

4.3 Regarding claims 12 – 51, the previous rejection of claims 4, 10 and 11 under 35 USC 102(e) (paragraphs 4.1 – 4.3 above) applies fully.

5. Claims 16, 18, 27, 30, 33, 41, 44, 46, and 49 are rejected under 35 U.S.C. 102(e) as being disclosed by Pardo (U.S. Pat. No. 6,266,539) (Telephone Docking Station for Personal Digital Assistant).

5.1 Regarding claim 16, Pardo discloses a PDA, comprising:

a memory for storing a list of phone features and phone policies therein
(Abstract; Figs. 7, 8, 12; col. 9, lines 2 - 20); and

software stored in the memory for allowing a user to select and program user's personal phone features and phone policies within the PDA from the stored list of phone features and phone policies (Abstract; Figs. 7, 8, 12; col. 7, lines 60 - 67; col. 9, lines 2 - 20).

5.2 Per claim 18, Pardo teaches that said software includes a feature/policy application program (API), said feature/policy API being used to interface the PDA with phone features and phone policies of the user (col. 7, lines 60 - 67).

5.3 Regarding claims 27, 30, 33, 41, 44, 46, and 49, the rejection of claims 16 and 18 (paragraphs 5.1 and 5.2 above) under 35 USC 102(e) applies fully.

Response to Arguments

6. Applicant's arguments filed 6/3/2003 (paper #13; Amendment B) have been fully considered but they are not persuasive.

7. Applicant states that Mattaway does not disclose that the PDA contains prestored identification data for the user of the PDA.

Examiner disagrees.

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It would have been inherent to prestore identity information in the PDA because security is a concern in Mattaway.

Allowable Subject Matter

8. Claims 1 – 3 and 5 – 9 are allowed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 703 305-8447. The examiner can normally be reached on 5 4 9.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER

PRIMARY EXAMINER

